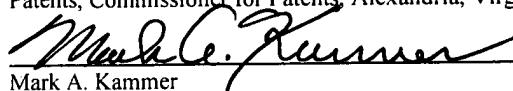




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Mark A. Kammer

APPEAL

Serial No.: 09/637,053

Filing Date: 8/11/00

GAU: 3625

Exam: Nguyen, C.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: **Cynthia Calonge**

SERIAL NO.: **09/637,053**

FILING DATE: **August 11, 2000**

TITLE: **Method for Providing Online Submission of Requests for Proposals for Forwarding to Identified Vendors**

ATTORNEY DKT. NO.: **1059.02**

GROUP ART UNIT: **3625**

EXAMINING ATTORNEY: **NGUYEN, Cuong H.**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

The Appeal Brief that follows is being filed within four (4) months of the mailing date of a Notice of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on October 13, 2005. A Petition and Fee for a three (3) month extension of the shortened statutory period of time for response is filed concurrently herewith. The fee for filing the Appeal Brief has been previously submitted. Applicant respectfully requests review of this Appeal Brief.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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APPEAL BRIEF



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REAL PARTY IN INTEREST

The Real Party in Interest of the present invention is Cynthia Calonge. There are no co-inventors and there are no assignments of rights or interests in this invention from Cynthia Calonge to any other party.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or the assignee, which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

The original application of the present invention contained three (3) claims. Claims 2 and 3 have been cancelled. Claims 4 – 6 have been added by amendment. Claim 1 is the only independent claim. Claims 4 and 5 depend from Claim 1. Claim 6 depends from Claim 4. Each of Claims 1 and 4 - 6 stands rejected. The rejection of each of Claims 1 and 4 - 6 is appealed.

A summary of the Claim status is as follows:

Claim 1	Rejected (as amended from original).
Claim 2	Cancelled.
Claim 3	Cancelled.
Claim 4	Rejected (as added by amendment).
Claim 5	Rejected (as added by amendment).
Claim 6	Rejected (as added by amendment).

STATUS OF AMENDMENTS

A First Office Action in the case was issued on November 20, 2002. Applicant filed an **Amendment and Response** on May 20, 2003.

A Final Office Action was issued on August 12, 2003. Applicant filed an **Amendment after Final** on October 14, 2003. An **Advisory Action** issued on February 19, 2004 indicating that the claim amendments would not be entered. Applicant filed an **RCE** on February 19, 2004.

A Non-Final Office Action issued on February 24, 2004 rejecting the claims under a single new patent reference [Applicant's amendments and arguments submitted with the RCE succeeded in overcoming the rejection based on U.S. Patent No. 6,085,169 Walker et al. (priceline.com).] Applicant filed an **Amendment and Response** on May 11, 2004, in response to a Non-Final Office Action mailed February 24, 2004. This Amendment **was entered**.

A Final Office Action was mailed October 8, 2004. **No Amendment after Final has been submitted in response to this Final Office Action.** A **Notice of Appeal** was filed on January 7, 2005.

Copies of Claims 1 and 4 - 6 as presently pending in the Application are attached hereto as **Exhibit A**.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention of the claims of the present Application that are on Appeal is a method of carrying out commercial transactions involving requests for proposals and pricing (RFPs) and the receipt of proposals in return from vendors. Specifically, the claims on appeal are directed to a system implemented over a wide area computer network that allows buyers to submit requests for proposals to a multitude of identified and selected vendors and to receive proposals in return from those vendors that choose to forward them (**Specification Page 2, Lines 10 – 14**).

The system of the claimed invention provides an online implemented software system and methodology that allows a prospective buyer to complete an electronic RFP document and to have that RFP document immediately (electronically) transmitted to one or more appropriate prospective sellers of goods and services (**Step 14 described at Specification Page 13, Line 19 – Page 14, Line 12 and FIG. 1 Step 14**). The prospective buyer is given the opportunity to have potentially appropriate sellers identified automatically (online) by means of a search function within a compiled database of vendor information and product and services descriptions (**Steps 16 and 20 described at Specification Page 14, Line 13 – Page 15, Line 2 and FIG. 1 Steps 16 and 20**). Alternatively the prospective buyer may elect to review the vendor database “manually” (but still online) by means of selecting specific subject matter areas or stepping through the vendor list one at a time (**Step 18 described at Specification Page 15, Lines 3 – 11 and FIG. 1 Step 18**).

The system then electronically forwards the buyer’s RFP to the selected vendors for review and consideration by appropriate personnel at the selected vendor’s business (**Step 30 described at Specification Page 16, Line 21 – Page 17, Line 19 and FIG. 1 Step 30**). This review may, at the vendor’s option, be carried out by an individual or automatically by the

vendor's own system which identifies a match with its range of offered goods and services. A proposal or price quote is then prepared and transmitted electronically back through the system to the prospective buyer for consideration (**Steps 42 - 46 described at Specification Page 17, Line 20 – Page 18, Line 19 and FIG. 2 Steps 42 - 46**). The buyer may then review the various proposals it receives and may select an appropriate vendor with which to carry out the commercial transaction (**Step 48 - 50 described at Specification Page 18, Line 20 – Page 19, Line 2 and FIG. 2 Steps 48 - 50**).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (1) Whether Claim 1 is unpatentable under 35 U.S.C. § 103(a), over U.S. Patent No. 5,758,328 to **Giovannoli**.
- (2) Whether Claims 4 - 6 are unpatentable under 35 U.S.C. § 103(a), over U.S. Patent No. 5,758,328 to **Giovannoli**.

A copy of **Giovannoli** is attached hereto within the Evidence Appendix (Appendix B).

ARGUMENT

1. The Examiner Erred in the Rejection of Claim 1 under 35 U.S.C. §103(a).

The Examiner initially rejected Claim 1 under 35 U.S.C. §102(b) as being anticipated by **Giovannoli** (U.S. Patent No. 5,758,328) and has now rejected the claim under 35 U.S.C. §103(a) in view of the same reference. The Examiner stated in the Final Office Action;

The arguments of the applicant submitted on 5/17/2004 are unpersuasive since although Giovannoli's patent may not be an art for 35 USC 102 rejection, the claimed steps are still obvious for a method for providing online submission of request for proposals for forwarding to identified vendors (please note that for step g) of pending claim 1, it is obvious for artisans to understand that selecting a vendor to "receive said RFP information" although it is not in original claim because that is what selection process for. [Emphasis added.]

Applicant had previously amended Claim 1 and had added new Claims 4 – 6 to clarify the distinctions between the present claimed invention and the method described in **Giovannoli**. The elements reflected in these amendments and in the arguments that followed, point out the fundamental differences between the present invention and the method steps disclosed in the only cited prior art (**Giovannoli**). The Examiner acknowledged that the reference was not appropriate for a 35 U.S.C. §102(b) rejection of the claims, but then erroneously used the same reference as a 35 U.S.C. §103(a) basis for rejecting the claims. The Examiner then makes a series of wholly conclusory statements about each of the missing elements in the cited reference being obvious. No additional references are cited as forming the basis for these rejections and no specific skill of one in the art is identified as making these additional limitations found in Claim 1 of the present Application obvious beyond the cited reference.

Giovannoli provides what may basically be described as an online catalog search engine and purchasing system. The key distinction to be aware of when comparing the **Giovannoli** methodology with the method of the present invention is that the **Giovannoli** method is vendor driven while the present invention is buyer driven. In **Giovannoli** the process of selecting a vendor (or group of vendors) to receive the request for quote (RFQ) and the process of responding with a price quote, are entirely automated, i.e. there is no human intervention (and thus no flexibility in the decision making) in the process except for two points; (1) the buyer's initial definition of the RFQ (by the buyer); and (2) the intermittent maintenance of a detailed vendor database (by the vendor). For this reason the system described in **Giovannoli** is little more than a catalog search engine. The potential buyer does not have the opportunity to review a list of selected vendors before the RFQ goes out. The selected vendors do not have the opportunity to individually review the RFQ and must instead maintain a sufficiently updated database to allow an automated response to the RFQ. It is the improved flexibility, and thus the improved efficiency, that distinguish the present invention over the method disclosed in **Giovannoli**.

Applicant provides below a summary diagram of the elements in Claim 1 in order to facilitate an understanding of the distinctions over the methodology described in **Giovannoli**. The steps and actions claimed in the present application may be characterized as follows:

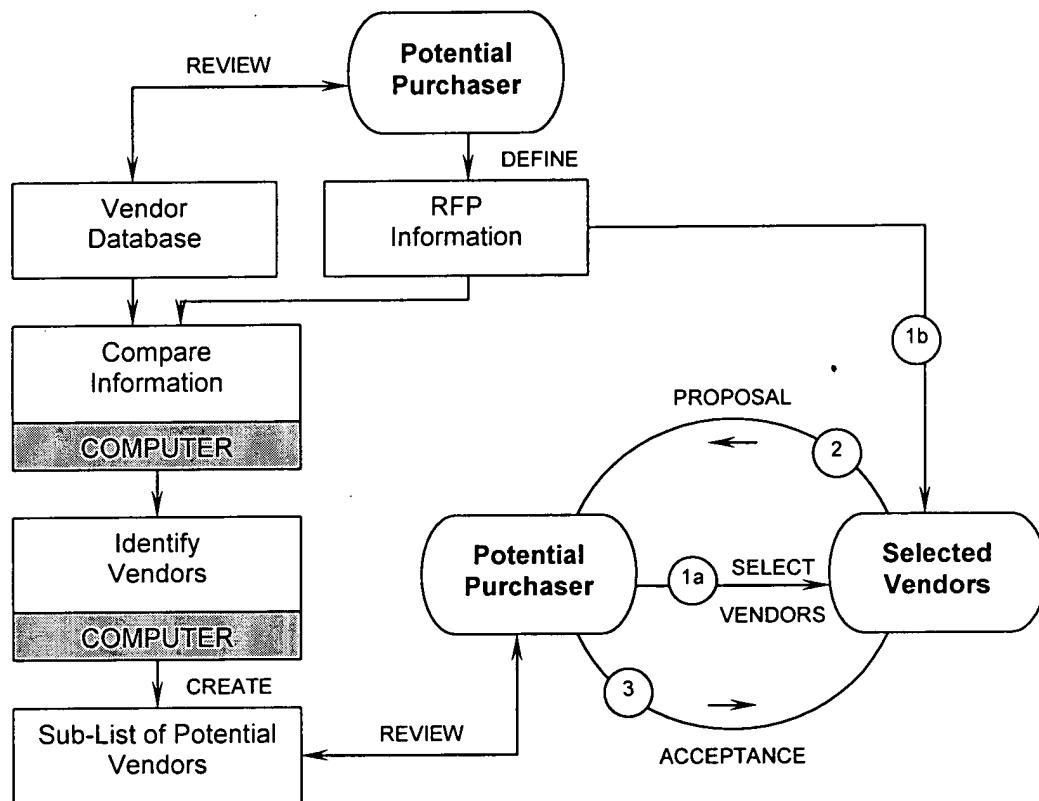


Diagram A – Claim 1 of the Present Application

Applicant would point out in particular the involvement of the individual Potential Purchaser and of the Selected Vendors in the information exchange process. Applicant would also note that the level of automation ("COMPUTER" actions), although significant, does not override the system. These features are distinct from the **Giovannoli** disclosure as discussed below.

Giovannoli on the other hand may best be characterized as describing a system intended to be more fully automated, and thus more restrictive to the buyer (and in the end, therefore,

more restrictive to the vendor) and more inefficient as a result. **Giovannoli** may be characterized as follows:

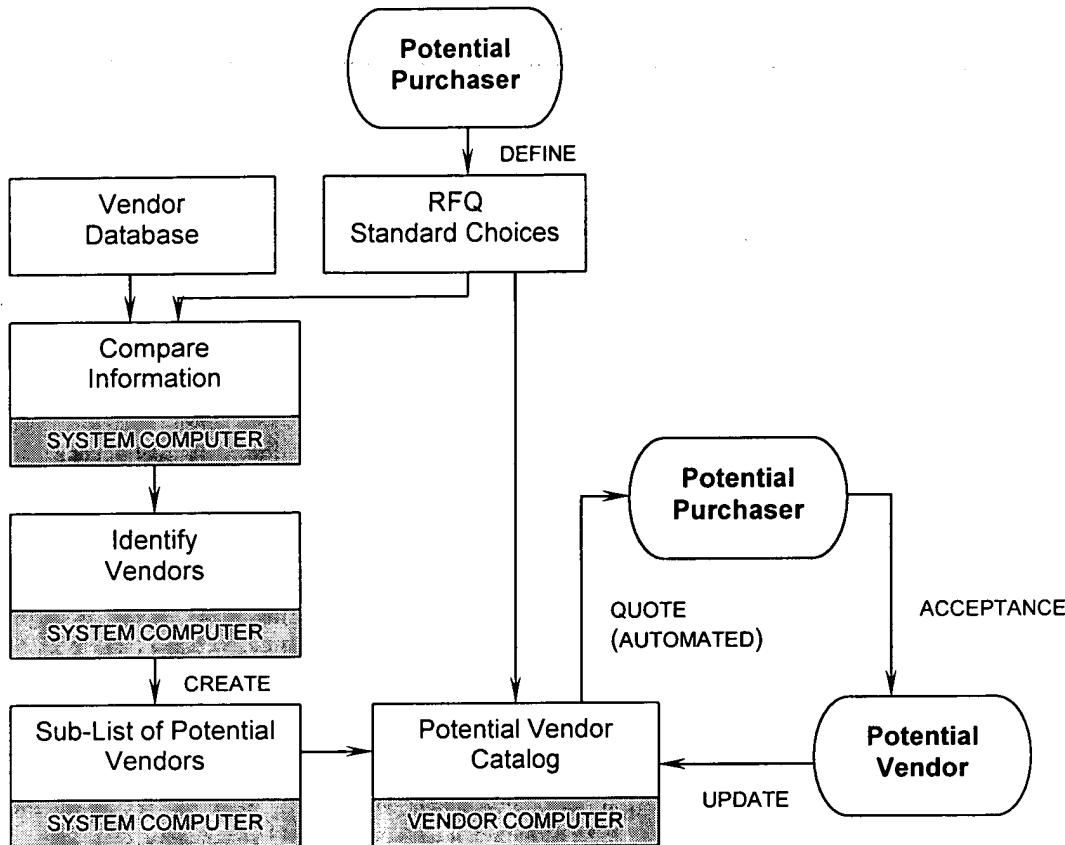


Diagram B - Giovannoli Methodology Summary

As indicated, the process in **Giovannoli** excludes intermediate interaction by both the Purchaser and the Vendor and is directed instead to a fully automated system with necessarily limited input parameters. Only the initial definition of the RFQ (which itself is a severely limited sequence of selections that the potential purchaser makes), the intermittent maintenance of the Vendor Catalog (by the Vendor), and the final acceptance of the price quote by the purchaser, involve non-automated input.

The Examiner has attempted to identify within **Giovannoli** each of the steps set forth in Claim 1 of the present application. Applicant respectfully contests the Examiner's view of a

number of the method steps in **Giovannoli** and their alignment with the claimed steps in the present application and herein identifies the basis for the Examiner's error in each instance.. Specifically the elements (method steps) discussed by the Examiner are as follows (with the Applicant's arguments in response thereto identified with each step):

Claim 1 Step (a) – “providing a database of vendor information...”

The Examiner points to **Giovannoli** column 4, lines 40-45 for this function. Applicant agrees that this step may be fairly characterized in **Giovannoli**. However, it is worth noting that the step of providing this database in the present invention includes giving the potential buyer access to the database prior to the formulation of the request for proposal (RFP). This and other active steps that the buyer participates in provide some of the underlying basis for distinguishing the present invention from that disclosed and taught by **Giovannoli**.

Claim 1 Step (b) – “providing a request for proposal (RFP) template...”

The Examiner points to **Giovannoli** at the Abstract and Figures 1 & 4 for this function. Applicant disagrees that this step may be fairly characterized in **Giovannoli**. Initially the distinction may be described as the difference between the way the buyer prepares the request for proposal (RFP) in the present invention, and the way the request for quotation (RFQ) is prepared in **Giovannoli**. In **Giovannoli** there are strict limitations on this process. The buyer is limited to a series of choices, first by selecting a product type and then by selecting a specific item or category of items. (See steps 2 and 3 in Fig. 2A). In the present claimed invention, the buyer is given the opportunity to prescribe an open ended RFP based on very specific or very broad requirements. In addition, the buyer in the present case is given the opportunity to integrate the information he or she learns from a review of the Vendor Database into the formulation of an RFP. None of these activities are available to the buyer in the **Giovannoli** system.

Claim 1 Step (c) – “receiving said RFP information...”

The Examiner points to **Giovannoli** at the Abstract and Figures 1 & 4 for this function.

Applicant agrees that, other than the distinction discussed above, this step may be fairly characterized in **Giovannoli**.

Claim 1 Step (d) – “comparing...RFP information with...vendor database...”

The Examiner points to **Giovannoli** Claim 4 and Figure 6 for this function. Applicant agrees that this step may be fairly characterized in **Giovannoli** but would point to the distinctive element found in amended Claim 1 of the present application regarding the ability of the buyer to review the vendor database so as to potentially have a role in the choice or definition of the vendors selected to receive the RFP. In addition, the opportunity of the buyer to review the vendor database in advance of completing the RFP template allows the buyer to structure the template to include or exclude individual vendors or groups of vendors.

Claim 1 Step (e) – “identifying vendors...offering goods and services...”

In conjunction with Step (d) above, the Examiner again points to **Giovannoli** Claim 4 and Figure 6 for this function. Applicant agrees that this step may be fairly characterized in **Giovannoli** but again recalls the input that the buyer had at the outset of the process in the initial review of the vendor database.

Claim 1 Step (f) – “generating a sub-list...for review by...[the] purchaser...”

The Examiner **has not identified** a similar disclosure in **Giovannoli** that relates to this important step as claimed in Claim 1 of the present application. Granted, the next step in **Giovannoli**, that of “broadcasting” the RFQ to a group of selected members inherently implies a list, but it is clear that this list is not generated for review by the purchaser. Instead, **Giovannoli** has long since taken control of the process out of the hands of the buyer and has restricted the selection process to the automated aspects of the “quotation system.”

Claim 1 Step (g) – “[the purchaser] selecting at least one potential vendor...”

Here again, the Examiner **has not identified** a similar disclosure in **Giovannoli** that relates to this important step as claimed in Claim 1 of the present application. **Giovannoli** allows for no involvement by the purchaser in the process until the final step of indicating actual acceptance of a price quote. In the present invention the review and final selection that is made by the purchaser is critical to an effective and efficient purchasing process. Without these steps (and without the possibility of an initial review of the vendor database by the purchaser) the purchaser is likely to be either overwhelmed by the number of respondent price quotes (or proposals in the present case) or is likely to receive price quotes for goods and services that do not truly match its needs.

Claim 1 Step (h) – “communicating...RFP information to...selected...vendors...”

The Examiner points to **Giovannoli** Abstract and Figures 1 & 4 for this function. Applicant agrees that this step may be fairly characterized in **Giovannoli** but would note that carrying out the step is driven directly by the purchaser. Because the purchaser has the opportunity to review the Sub-List of potential vendors and to select there from, there is in fact an action (a “send RFP” mouse click for example) that the purchaser takes before this step is carried out in the process. To the extent that the step in the present invention would not be carried out if it were not for the actions of the purchaser, it is distinct from the fully automated actions being carried out in **Giovannoli**.

Claim 1 Step (i) – “communicating a response from...selected...vendors...”

The Examiner points to **Giovannoli** in the Abstract for this function. Applicant disagrees that this step may be fairly characterized in **Giovannoli**. Applicant points specifically to Figure 2A in **Giovannoli** for a clear description of this step that is broadly referenced by the Examiner pointing to the Abstract. Throughout the **Giovannoli** disclosure the emphasis is on the ability of

the vendor to utilize this system without the need for significant interaction beyond the maintenance of its own vendor database information. In Figure 2A, the last step in the flowchart diagram, it specifically states; “THIS [the vendor response to the request] IS DONE AUTOMATICALLY USING SOFTWARE PROVIDED BY THE QUOTATION SYSTEM TO EACH VENDOR” (emphasis added). The automated nature of this step is further reinforced by the description in the text of the **Giovannoli** disclosure at column 5, lines 43-49 wherein it states; “...the quotation system would interrogate [sic] the vendor’s product database (using suitable software which links or cross references the vendor’s inventory to the quotation system product and services list) and retrieve pricing and other information necessary to respond to the RFQ; and thereafter prepare e-mail to be sent to the requesting buyer member.”

The Examiner therefore erred in rejecting Claim 1 under 35 U.S.C. §103(a) without any support for those elements clearly distinct (and/or missing) from the cited reference, either from other patents in the field or from an understanding of one skilled in the art.

2. The Examiner Erred in the Rejection of Claims 4 - 6 under 35 U.S.C. §103(a).

In its last amendment and response Applicant had amended Claim 1 and had added Claim 4 - 6 to introduce elements and to clarify other elements that help to highlight the distinctions between the present invention and the methodology disclosed in **Giovannoli**. The system described in **Giovannoli** has as one of its primary goals the complete automation of the buying process such that the system becomes little more than the combination of a search engine and a plurality of vendor catalogs. Experience has shown that such a system typically fails to match buyers with sellers efficiently simply because the matching process is imperfect when fully automated.

The present invention finds a balance between automation and human interaction that provides a system of greater efficiency in appropriately putting together buyers and sellers of

goods and services. This balance is not taught or anticipated by **Giovannoli** in part because of its focus on full or nearly full automation. The Examiner erred by not discerning these distinctions developed and claimed in dependent Claims 4 – 6 on Appeal herein.

The Examiner therefore erred in rejecting Claims 4 – 6 under 35 U.S.C. §103(a) by not providing any support for the alleged obviousness of the elements clearly distinct between the only cited reference and the dependent claims in the present Application. The Examiner provided no assistance in discerning to what basis arguments might be directed to debate the obviousness issue. Applicant is forced to conclude that the Examiner has viewed the art in retrospect with the benefit of the present disclosure to arrive at a conclusion of obviousness.

3. General

Every issue identified above includes the question of the applicability of the **Giovannoli** cited references. The Examiner has erred generally by drawing in non-analogous art, ignoring the differences not only in the process of deciding whether the art should be seen as relevant, but also ignoring the process step differences in lining up the art against the process step limitations claimed in the present case. The Examiner has erred by viewing the claimed invention as being merely a semantic variation of the methodology disclosed in the single cited reference from the prior art. Certainly the claims as presently stated are not so vague as to lead one to view them as encompassing such a sweeping coverage. The present invention is specific to an RFP process and does not encompass other online purchasing processes. This is especially true when both the processes in the prior art are different and the purpose of the claimed method is different. In summary, the Examiner erred by citing non-analogous art and further erred by then failing to associate and align all elements in the claims with any analogous elements in the cited references.

CONCLUSION

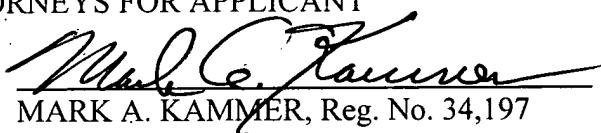
For the foregoing reasons, Appellant believes that the Examiner's rejections of Claims 1 and 4 - 6 were erroneous, and reversal of his decision is respectfully requested.

Respectfully submitted,

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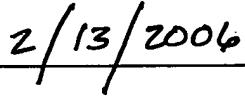
ATTORNEYS FOR APPLICANT

By:



MARK A. KAMMER, Reg. No. 34,197

Date



2/13/2006

CLAIMS APPENDIX (APPENDIX A)

Claim 1. A method for establishing and brokering a transaction between purchasers and vendors over a wide area computer network, the method comprising the steps of:

 providing a database of vendor information to at least one potential purchaser for review by said potential purchaser, said vendor information comprising descriptions of the goods and services offered by a plurality of vendors;

 providing a request for proposal (RFP) template to said at least one potential purchaser over said wide area computer network;

 receiving RFP information from said at least one potential purchaser into said RFP template, over said wide area computer network, said RFP information comprising a description of the goods and services required by said at least one potential purchaser;

 comparing said description of the goods and services required by said at least one potential purchaser in said RFP information with said descriptions of the goods and services offered by said plurality of vendors in said vendor database, said comparing step carried out automatically by computer;

 identifying vendors in said vendor database offering goods and services similar to said goods and services required by said at least one potential purchaser, said identifying step carried out automatically by computer;

 generating a sub-list of potential vendors identified in said identifying step for review by said at least one potential purchaser;

 selecting at least one of said potential vendors from said generated sub-list to receive said RFP information, said selecting step carried out by said at least one potential purchaser;

 communicating said RFP information to said selected potential vendors;

communicating a response from at least one of said selected potential vendors to said at least one potential purchaser, said response comprising a proposal to provide goods and services to said at least one potential purchaser at a specified price and according to specified terms; and communicating an acceptance or a rejection from said at least one potential purchaser to said at least one of said selected potential vendors.

Claims 2 – 3 (cancelled).

Claim 4. The method of Claim 1 wherein said step of receiving RFP information from said at least one potential purchaser further comprises receiving vendor selection criteria established by said at least one potential purchaser after said review of said vendor information by said at least one potential purchaser.

Claim 5. The method of Claim 1 wherein said step of communicating a response from at least one of said selected potential vendors to said at least one potential purchaser, comprises said at least one of said potential vendors reviewing said RFP information, generating a proposal in response to said RFP information, and transmitting said proposal to said at least one potential purchaser.

Claim 6. The method of Claim 4 wherein said step of communicating a response from at least one of said selected potential vendors to said at least one potential purchaser, comprises said at least one of said potential vendors reviewing said RFP information, generating a proposal in response to said RFP information, and transmitting said proposal to said at least one potential purchaser.

EVIDENCE APPENDIX (APPENDIX B)

GIOVANNOLI, U.S. Patent No.: 5,758,328, Issued May 26, 1998, Entitled: Computerized Quotation System and Method.

RELATED PROCEEDINGS APPENDIX (APPENDIX C)

None